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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,259	01/27/2004	Mario Grazioli	DT-6748	4143
30377	7590	09/19/2005	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			WEEKS, GLORIA R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,259

Applicant(s)

GRAZIOLI ET AL.

Examiner

Gloria R. Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

1. This action is in response to Applicants' amendments and arguments received on June 16, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner et al. (USPN 5,903,462).

In reference to claims 1-8, Wagner discloses a hand-held work tool, comprising: a housing (110); including a setting mechanism (column 1 lines 35-40); and at least one acceleration sensing device (306) for detecting acceleration forces occurring during a setting impulse; a handle part (120); an internal interface (112) for at least one of data communication and data output is arranged on the hand-held tool, and communicates with an external interface (column 10 lines 14-17) for providing data input and data output, the external interface having an optical data display unit (column 7 lines 1-2), operating elements, and signal means (210); an internal interface evaluation and storage mechanism (column 6 lines 58-66) and an external interface evaluation and storage mechanism (remote software) for processing and storing data detected by the sensing device (306); and at least one discriminating means (310) for differentiating between impulses caused by the setting impulse and other acceleration forces.

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4. Claims 1, 4, and 24 are rejected under 35 U.S.C. 102(b) as being unpatentable over Mallick, Jr. et al. (USPN 4,051,351).

In reference to claims 1 and 4, Mallick, Jr. et al. discloses a hand-held working tool comprising: a housing (12); a handle (column 1 line 23); a work mechanism (8); a sensing device capable of monitoring acceleration forces by the work mechanism (column 4 lines 3-10), as well as the pressure of gas released by the work mechanism (column 6 lines 19-25); and an interface (30) for data communication and data output, whereby discriminating means differentiate between impulses (column 13, lines 44-49).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (USPN 5,903,462) in view of Schmitzer et al. (US 2003/0006051).

Regarding claims 9-13 Wagner et al. discloses a hand-held work tool comprising an internal interface (112) for data communication and data output regarding impulses within the tool, wherein the interface (112) has an evaluation and storage means for real-time measurements, the storage means having storage areas allocated to specific characteristics via an operator (column 4 lines 9-60); means for initializing and disabling a sleep-mode (column 3 lines 45-47); an external interface having input means for entry of user-specific identification

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characteristics (column 10 lines 14-50). Wagner et al. does not disclose the internal interface having means to specifically monitor the handle of the tool.

Schmitzer et al. teaches a hand-held work tool, comprising: a housing (1) including a handle (2) and a setting mechanism (3); and at least one acceleration sensing device (11) located on the handle (3) for detecting acceleration forces occurring during a setting impulse; an internal interface (7) for data communication and data output is arranged on the hand-held tool; an internal interface evaluation and storage mechanism (page 1 paragraph 11) for processing and storing data detected by the sensing device (11), wherein the evaluation and storage unit detect acceleration load absorbed by the handle and transferred to an operator. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the tool of Wagner et al. to include the handle sensor of Schmitzer et al. for the purpose of monitoring and reducing vibration transferred to the operator through the handle (Schmitzer et al.-page 1 paragraphs 4 and 9).

Response to Arguments

7. Applicant's arguments filed June 16, 2005 have been fully considered but they are not persuasive.

Claim 1 recites the phrase "a sensing device for detecting acceleration forces" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since this language does not meet the analysis set forth in MPEP 2181, i.e. "means for" or "step for" is not being used, the Examiner has not invoked 35 USC 112, paragraph 6. Thus, the limitations of claim one are limited to a hand-held tool comprising a housing including a setting mechanism, striking mechanism, a sensing device and a handle with

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a data interface. No weight is given to the limitations drawn to the functionality of the cited mechanisms/devices. However, column 4 lines 12-22 of Mallick discloses an equation incorporating the acceleration force of the work mechanism (8), which is detected/measured from the working tool.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Wagner discloses a hand-held tool that applies torque and speed to fasteners, whereby it is known that such torque and speed are capable of creating vibration in the handle of the tool. Thus, Scmitzer et al. teaches a preventive and monitoring device for hand-held tools subject to vibration in the handle portion of the tool, for the purpose of reducing such vibrations.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R. Weeks whose telephone number is (571) 272-4473. The examiner can normally be reached on 8:30 am - 7:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gloria R Weeks
Examiner
Art Unit 3721



grw
September 15, 2005



SCOTT A. SMITH
PRIMARY EXAMINER